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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,164

12/27/2005

Dong-Suk Song

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35884

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10/09/2007

LEE, HONG, DEGERMAN, KANG & SCHMADEKA

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EXAMINER

LEWIS, KIANDRA CHARLE

ART UNIT

PAPER NUMBER

3772

MAIL DATE

DELIVERY MODE

10/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/563,164

Applicant(s)

SONG, DONG-SUK

Examiner

Kiandra C. Lewis

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3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claim 13 is objected to because of the following informalities: Trademarks cannot be used in claims. Claim 13 recites the limitation of Velcro ®. The generic term must be used. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1,2-4,6,7,10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardiner US 6,196,986 in view of Swallow et al. US 4,021,860 in view of Huggins et al. US 7,051,457.

As to claim 1, Gardiner et al. disclose a foot protection device (10) comprising an exterior cover comprising an opening (32), a posterior hole (22) provided on a sole

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portion (see fig. 4) to insert parts (16) provided on a toe portion (14) and ankle securing means (44,46) provided at an end of an ankle portion. Gardiner et al. substantially discloses the invention as claimed, but does not expressly state that there is an anterior hole. Gardiner et al. teaches an anterior portion (60) but does not disclose it to be hole. Swallow et al. teaches a foot protection device having an anterior portion ('860, fig. 3) in which there is a hole (32) provided as well as material for traction (34). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Gardiner et al. to include an anterior hole as taught by Swallow et al. for the purpose of being able to inspect the upper anterior portion of the foot, including the toes (col. 2, lines 48-50). Gardiner et al. and Swallow et al. substantially disclose the invention as claim, but do not expressly state that the toe portion has toe holes. Huggins et al. teach a foot protection device having toe holes (see fig. 12). Huggins et al. teach that such a modification is necessary in foot protective wear to protect the feet from burns, blisters, and other foot problems (col. 1, lines 52-54). Huggins et al. further teach that protective such protective footwear is needed for many different floor surfaces (col. 1, lines 63-65) and in many different environments (col. 1, line 65-col. 2, line 4). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the foot protection device of Gardiner et al. and Swallow et al. to include the toe inserts as taught by Huggins et al. for the purpose of increased friction and reducing slippage when wearing the foot protection device (col. 3, lines 32-37).

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As to claim 2, the above combination teaches an upper piece having cut parts ('457, the toe inserts) and a lower piece having an anterior hole ('860, 32) and a posterior hole ('986, 22).

As to claim 3, the above combination teaches an instep protective cover (13) of the exterior cover ('986, 12).

As to claim 4, the above combination teaches an ankle protective cover (40) of the exterior cover (30).

As to claim 6, the instep protective cover (13) extends to the toe portion (fig. 4).

As to claim 7, the instep protection cover (13) extends to the toe portion (fig. 4, 14) and to the ankle portion (18).

As to claim 10, the above combination teaches a coupling part (50) fixed to the ankle portion of the exterior cover and a flap (44) extended away from the coupling part (50) to cover a portion between the instep and ankle portion while the flap (44) is not fixed to the exterior cover.

As to claim 15, the above combination teaches that the toe insert parts ('457, 32) are made of a material different from that of the rest of the foot protection device ('457, col. 3, lines 51-56, fig. 3).

Claims 5, 8, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardiner '986, Swallow et al. '860 and Huggins et al. '457 as applied to claim 1 above, and further in view of Brother et al. US 6,234,988.

As to claims 5, 8 and 9, Gardiner, Swallow et al. and Huggins et al. substantially disclose the invention as claimed, see rejection to claim 1 above, but do not expressly disclose the invention to include a cushioning layer between the instep protective cover or ankle protective cover. Brother et al. teach a foot protection device ('988, fig. 1) having a cushioning layer (col. 5, lines 19-23) for the purpose of absorbing shock for impact (col. 4, lines 33-37). Brother et al. further teach that the foot protection device is needed to help reduce injury or pain in high impact situations (col. 4, lines 48-55). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to including a cushioning layer as taught by Brother et al. in the foot protection device of Gardiner, Swallow et al. and Huggins et al. for the purpose of increasing the protection of the user's foot and reducing ankle injury (col. 3, lines 33-37; col. 4, lines 45-48).

As to claim 11, the above combination teaches that the cushioning layer may be comprised of a foam material and it is known that foam material is porous (col. 3, lines 17-20).

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardiner '986, Swallow et al. '860 and Huggins et al. '457 as applied to claim 1 above, and further in view of Corry US 5,867,838.

Gardiner, Swallow et al. and Huggins et al. substantially disclose the invention as claimed, see rejection to claim 1 above, but do not expressly state there is an elastic portion provided at the end of the ankle portion. The above combination teaches

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fastening means ('986, Velcro ®) as fastening means at the ankle portion. Corry teaches a foot protection device ('838, 10) comprising an elastic band ('838, 28) at the ankle portion of the device. It would have been obvious to one having ordinary skill in the art at the time of the invention to include an elastic portion as taught by Corry at the ankle portion of the device of Gardiner, Huggins et al. and Swallow et al. for the purpose of ensuring that the foot protection device properly engages the ankle of the user ('838, col. 3, lines 54-56).

As to claim 13, the above combination teaches Velcro ® as a fastening means ('986, col. 2, lines 22-26).

As to claim 14, the above combination teaches a cut part (along the edges of the ankle portion) that provides an opening to expose the ankle (fig. 3).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 4,651,354 US 5,412,957 US 5,682,617 US 5,899,872 US 7,107,626.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiandra C. Lewis whose telephone number is 571-272-7517. The examiner can normally be reached on Mon-Thurs 9AM-6PM and alternating Fridays 9AM-5PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCL
[Signature]
10/1/04

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